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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/536.345	09/29/95	TEMPLE	S 27754/32937

MM12/0927

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EXAMINER

DALAKIS, M

ART UNIT

PAPER NUMBER

2851

DATE MAILED:  
09/27/99

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
08/536,345

Applicant(s)

Temple et al.

Examiner  
Michael Dalakis

Group Art Unit  
2851



☒ Responsive to communication(s) filed on Jul 15, 1999

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 34-45, 59-64, 67-69, 72, 73, and 75-80 is/are pending in the application.

Of the above, claim(s) 79 and 80 is/are withdrawn from consideration.

☒ Claim(s) 34-45 and 59-64 is/are allowed.

☒ Claim(s) 67-69, 72, 73, and 75-78 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 3,19

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## DETAILED ACTION

### *Election/Restriction*

1. The amendment filed on July 15, 1999 introduces new claims 79 and 80. These claims depend off of non-elected claim 20. These claims are withdrawn from consideration by the examiner as being drawn to a non-elected invention.
2. This application contains claims 20-33, 46-58, 65, 66, 70, 71, 72, 73, 79 and 80 drawn to an invention nonelected with traverse in Paper No. 8. A complete reply to the final rejection must include cancelation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

### *Claim Rejections - 35 USC § 112*

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 75-78 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. New claims 75-78 recite the limitation of a transverse duct having an array of parallel conductive tracks spaced at intervals corresponding with the channel spacing. The applicant states that this features is found on page six and in Figure 1 of the present specification. The examiner respectfully disagrees. This disclosure is not found in the present specification or illustrated in the drawings.

### *Double Patenting*

5. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

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A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

6. Claims 75-78 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 9 of prior U.S. Patent No. 5,463,414. This is a double patenting rejection.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 67-69 and 72-73 are rejected under 35 U.S.C. 103(a) as being unpatentable over Temple ('028) in view of Bartky et al. Temple teaches a high density multi-channel array, electrically pulsed droplet deposition apparatus comprising a plurality of modules each including a layer of piezo-material poled normal thereto, a channel for ink droplets, separating walls, electrodes, a channel closure sheet, a nozzle plate and means for supplying liquid to the channels. Bartky teaches a multi-channel array comprising a plurality of modules including a channel and separating wall wherein separating wall surface has an electrode which causes the wall to eject droplets upon shearing, a channel cover sheet having electrodes opposite the channel, drive circuits connected to electrodes, and a manifold. It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Bartky into those of Temple, for the motivation, as suggested by Bartky, of providing an ink jet actuator having improved efficiency.

***Allowable Subject Matter***

9. Claims 34-45 and 59-64 are allowable over the prior art.

***Response to Arguments***

10. Applicant's arguments filed July 15, 1999 have been fully considered but they are not persuasive. The applicant has not addressed the examiner's comments from the previous office

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action. The applicant has merely repeated his argument from January 29, 1999, generally alleging that neither of the two references disclose mechanical bonds between conductive tracts on a cover sheet and electrodes on channel-facing walls, which bonds seal the cover sheet to the channels. However, the examiner does not find this feature recited in claims 67-69 or 72-73. The applicant has not provided any additional arguments traversing the rejection of these claims. Therefore, the rejection is being maintained.

### *Conclusion*


11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Dalakis at telephone number (703)305-3307. The examiner can normally be reached Monday through Thursday from 6:30 AM to 5:00 PM. If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on (703)308-1436. The fax number for this Group is (703) 305-34[31,32]. Any inquiry of a general nature as to the status of this application should be directed to the Group receptionist at (703)308-1782.

*MD*  
MD

September 27, 1999

  
Safet Metjahic  
Supervisory Patent Examiner  
Technology Center 2800